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APPLICATION NO. 026694	FILING DATE 10/05/99	FIRST NAMED INVENTOR EGGLESTON	ATTORNEY DOCKET NO. Y CVC-002.02
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TM02/0926

EXAMINER POINVIL, F	
ART UNIT 2164	PAPER NUMBER

DATE MAILED:

09/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/412,137

Applicant(s)
EGGLESTON ET AL.

Examiner
Frantzy Polnvi

Art Unit
2164



- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/11/01 and 7/27/01
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 34, 35, and 39-58 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 34, 35, and 39-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-3, 6, 10-15, 17 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Storey.

As per claims 1-3 and 49, Storey discloses a fully integrated online interactive frequency and award redemption system. The system comprises a host computer coupled to a network; a database of the host computer (note figure 2 of the drawings) accessible from the host computer; and an automated award fulfillment application program executable on the host computer for participation in incentive programs of a plurality of providers (note column 3, line 61 to column 4, line 10).

As per claim 10, Storey discloses having more than one programs whereby different companies manage different incentive programs. Note column 4, lines 3-10. The Internet includes a browser coupled to the host computer.

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Claims 6 and 11 contain limitations addressed in claim 1 and these limitations are rejected under a similar rationale. As per the claimed database of awards associated with the incentive program, applicant is directed to column 4, lines 1-26. As per an application program for automating the fulfillment for the incentive program, applicant is directed to column 7, line 45 to column 8, line 54.

As per claim 12, Storey discloses having a plurality of companies having different incentive programs. Note column 4, lines 3-27. The awards are stored in award database.

As per claim 13, note column 4, lines 3-27.

As per claim 14, applicant is directed to the rejection of claim 7 above.

As per claim 15, note column 8, lines 17-41.

As per claim 17, note also column 5, lines 36-42.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9 and 16 are rejected under 35 USC 103(a) in view of Storey.

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As per claim 4, the teachings of Storey are discussed above. The system also comprises a user located remotely (thus a client computer of a consumer or user is present for accessing the system) and operating the automated award fulfillment. Note column 2, lines 54-65. The system also comprises a server for the host computer (note figure 1) and a web site located on the server of the host computer wherein the consumer may participate in incentive programs of the plurality of independent providers via the web site. Note also column 2, lines 54-65 wherein it is described that the user accesses the system via the Internet or Netscape or CompuServe thus implying accessing providers' websites.

The system comprises a user computer and a server or host computer therefore, a computer network having a first and a second workstation and being capable of transferring electronic data between the workstation wherein the first workstation is the host computer (note figure 1);

providing each of the host computer and the workstation with an application program capable of responding to input from the host computer or workstation (note column 3, lines 1-61);

allowing a user of the host computer to operate the automated award fulfillment application program to generate an incentive program and to store the incentive program on the host computer (column 3, line 7 to column 4, line 52);

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transferring a stored incentive program to the workstation and providing an address for the stored incentive program from the network would have been obvious to the skilled artisan since it is noted that the user accesses and retrieves award information from the host computer.

As per claim 5, note column 2, lines 15-27; column 4, lines 11-26 and column 10, lines 3-6 of Storey.

As per claim 7, Storey does not explicitly teach providing a card for fulfillment of awards won in the incentive program. The Examiner takes official Notice that different types of cards such as magnetic cards and smart cards are usually given to consumers for holding fulfillment data and prizes won. It would have been obvious to one of ordinary skill in the art at the time of the invention to introduce such a feature in Storey with the motivation of providing users with a device to redeem prizes at selected stores.

As per claim 8, Storey discloses that a user inputs his personal identification number. Note column 6, lines 44-47. Having a memory for storing the user's PIN would have been obvious to the skilled artisan for correlation with stored PINs and also to prevent unauthorized access to the system.

As per claim 9, note column 5, lines 36-42.

As per claim 16, Storey discloses that a user inputs his personal identification number. Note column 6, lines 44-47. Having a memory for storing the user's PIN would have been obvious to the skilled artisan for correlation with stored PINs and also to prevent unauthorized

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access to the system. Storing the PIN in a memory card would have been obvious to the skilled artisan to enable authorized usage of the card.

4. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storey in view of Goldhaber et al.

The teachings of Storey are given above. As per claims 33 and 34, these claims contain limitations addressed in claims 18 and 22 and these limitations are addressed likewise. Claim 33 additionally recites an award association application program. This feature is taught on column 10, lines 8-38 of Goldhaber et al. Fulfillment application program for associating a fulfillment method is not explicitly taught by Goldhaber et al. Storey discloses an on-line interactive frequency and award redemption program. Note the abstract and column 10, lines 1-6 of Storey. It would have been obvious to one of ordinary skill in the art to introduce the teachings of Storey into Goldhaber et al with the motivation of maintaining an account of users balance and transactions.

5.

ARGUMENTS

Applicant argues that Storey does not provide an automated fulfillment because Storey shifts the actual fulfillment to a fulfillment house or directly to a product manufacturer and cited column 10, lines 4-5. Applicant further states that contrary to Storey, the claimed invention provides automated fulfillment by having a sponsor of a program designating what award will be provided and the location for redemption by the consumer user.

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The Examiner disagrees with applicant's arguments. Both the claimed invention and the system of Storey provides an automated award fulfillment since both the claimed invention and the system of Storey provides an award to a user and permits selection of a prize or award. The difference between the claimed invention and that of Storey, a difference or limitation which is not being claimed in the independent claims is the method of the consumer receiving the actual prize or award. Storey directs or links a fulfillment house or product manufacturer which subsequently deliver the product to the award recipient whereas in the instant invention, fulfillment is established by instructing the consumer to a location to obtain/pick up the prize or award. Note page 97, lines 15-20 and page 99, line 4 to page 100, line 5 of the instant invention. Thus the only difference between the two systems is the method in which the consumer obtains the product. Directing a consumer to pick up the prize at a particular store or location (the instant invention) or directing instructions to a manufacturer to provide the winning prize to a consumer are obvious preferred differences to one of ordinary skill in the art.

These differences are being claimed in claims 39-58. Thus, arguments regarding claims these features are not persuasive.

6. Claims 40-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over as applied to claim above, and further in view of Von Kohorn (5,916,024) and Scroggie et al (US Patent No. 6,014,634).

The teachings of Storey et al and Goldhaber are discussed above. As per the limitations of receiving a user demographically tailored selection of a sponsor designated award tailored to at

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least one of demographic and psychographic preferences of the consumer, these practices are well known in the art of prize redemption systems as evidenced by Von Kohorn and Scroggie et al.. Von Kohorn and Scroggie et al teaches providing an award fulfillment system whereby customers are directed to locations to redeem prizes or awards. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these teachings into Storey or the combination of Storey and Goldhaber et al in order to the customer with control of obtaining/redeeming the prize.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil, whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 5:00 PM.

The fax phone number for this Art Unit is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

FP
24Sep01

F Poinvil
Frantzy Poinvil
Primary Examiner
Art Unit 2164